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BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER

HEWITT II, CALVIN L

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3621

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 37

Application Number: 08/979,567
Filing Date: November 26, 1997
Appellant(s): SHIOTA ET AL.

D. Richard Anderson, Reg. No. 40,439
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 30 August 2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the

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decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(4) Status of Amendments After Final

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 1, 2, 5-7, 10 and 12, claims 11 and 25, claims 13, 14, 17-20 and 26, claim 27, claims 3, 8, 15 and 21, and claims 28-33 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,799,219	MOGHADAM et al.	8-1998
5,930,810	FARROS et al.	7-1999

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Response to Arguments

Initially, the Examiner would like to apologize for any lack of clarity on his part. When the Examiner pointed out that the Applicant's claims, "do not mandate that both sets of data be stored on the same recording medium as suggested by the Applicant (paper 27, page 11, lines 19-21)", it was done only to indicate that the feature in dispute was not included in the claims and not to imply that said feature was not disclosed by Moghadam et al.. On the contrary, in paper no. 30, page 2, lines 5-11, the Examiner clearly states that Moghadam et al. teach storing image data and printing service information on the same recording medium. Hence, the only difference between the prior art combination of Moghadam et al. and Farros et al., and the Applicant's [amended] claimed invention is the portability of the recording medium. And, while this is taught by Moghadam et al. (the film is stored on a cartridge) (column/line 7/35-8/26), it has

been held that such a modification is considered to be within the level of ordinary skill of the art (*In re Lindberg*, 194, F.2d 732, 735, 93 USPQ 23, 26 (CCPA 1952)), therefore, the Examiner maintains the rejection, as it would have been obvious to one of ordinary skill to record image data and updateable printing service information on the same portable recording medium.

Claim Rejections - 35 USC § 103

Claims 1-3, 5-8, 10-15, 17-21 and 23-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moghadam et al, U.S. Patent No. 5,799,219 in view of Farros et al., U.S. Patent No. 5,930,810.

As per claims 1-3, 5, 6, 11-13, 18, 19 and 25-27, Moghadam discloses a picture print ordering system comprising the steps of recording picture image data obtained by reading a developed film at a primary and secondary storage unit (figure 4). Moghadam provides for the generation, display and input of printing service related data such as size, quantity, availability and service provider (figures 3 and 5; column 1, lines 55-64; column 4, lines 1-46; column 6, lines 1-10 and 35-67; column 7, lines 3-26; column 8, lines 1-26). Regarding high-resolution images, Moghadam et al. disclose user selection of image resolution (column 6, lines 1-10 and 54-55). Therefore, it would have been obvious to one

of ordinary skill in the art to apply the system of Moghadam et al. to high resolution image processing. Although, a user of the Moghadam et al. system utilizes a plurality of print service related data in order to facilitate remote image processing (column 6, lines 1-55; column 8, lines 1-26), it is not however, explicit as to whether this data is displayed to the user. Farros et al. teach a printing system that allows a user to view print service information that includes a plurality of attributes (figures 1, 4, 7 and 10, column/line 10/38-11/21) and price data (column 4, lines 37-66). Specifically, Farros et al. teach updateable information for use in generating an updateable order screen displaying available printing services from which a user can select services (figures 5-7; column/line 7/44-8/25). And like Moghadam et al. (figures 3 and 4), Farros et al. teach primary and secondary storage units, as well as using a communications network to produce a user defined "finished product" (figure 4; column 2, lines 60-67; column/line 3/65-4/15; column 7, lines 6-36; column/line 8/9-9/31; column 10, lines 1-36; column 11, lines 22-67). Therefore, it would have been obvious for one of ordinary skill of the art to combine the teachings of Moghadam et al. and Farros et al. Both teach systems that apply modern technological innovations to visual data processing. Specifically, they allow users to communicate processing

specifications (e.g. place an order) directly with service providers over a global network. However, by implementing the system with visual verification and a receipt ('810, column 11, lines 22-67), a user of the Moghadam et al. system can provide evidence of service a request in the event of processing or payment errors.

As per claims 28-33, Moghadam et al. disclose a picture print ordering system that provides for the generation, display and input of printing service related data such as size, quantity, availability and service provider (figures 3 and 5; column 1, lines 55-64; column 4, lines 1-46; column 6, lines 1-10 and 35-67; column 7, lines 3-26; column 8, lines 1-26). Although, a user of the Moghadam et al. system utilizes a plurality of print service related data in order to facilitate remote image processing (column 6, lines 1-55; column 8, lines 1-26), it is not however, explicit as to whether the final order is displayed to the user. Recall Farros et al. use receipts and visual confirmation to implement their system, as well as providing an updateable order screen ('810, figures 5-7; column/line 7/44-8/25; column 11, lines 22-67). Receipts and visual confirmation reflect updated information. They also provide evidence of a users service requests and items and/or services purchased. Hence, they necessarily indicate to a user current printing service capabilities of a printing service. Therefore, it would have been obvious to combine the teachings of Moghadam et al. and Farros et al. By implementing the Moghadam et al. system with visual verification and a receipt, a

user can provide evidence of a requested service if he/she is dissatisfied with the finished product and also check for front-end input errors on the part of the user.

As per claims 7, 14, and 20, they are similar to claim 2. Therefore, the rejection of claim 2, is being applied to claims 7, 14 and 20.

As per claims 8, 15 and 21, they are similar to claim 3. Therefore, the rejection of claim 3 is being applied to claims 8, 15 and 21.

As per claims 10, 17 and 23, they are similar to claim 5. Therefore, the rejection of claim 5 is being applied to claims 10, 17 and 23.

As per claim 24, it is similar to claim 18. Therefore, the rejection of claim 18 is being applied to claim 24.

(11) Response to Argument

The Appellant is of the opinion that the prior art combination of Moghadam et al. and Farros et al. is insufficient for establishing a prima facie obviousness rejection to the Appellant's claims. Specifically, the Appellant asserts that the prior art does not teach "...printing service information being updateable information for use in generating an updateable order screen displaying available printing services from a user selects" (Appeal Brief, page 13, lines 9-11 and 15-20; page 16, lines 10-19; page 19, lines 10-15 and 19-23; page 21, lines 6-16).

Initially, the Examiner felt that that a so-called "updateable order screen" feature was not explicit recited by Moghadam et al.. However, upon closer

inspection this is clearly taught and explicitly recited by Moghadam et al.. Specifically, after initial film processing a finishing station forwards, either electronically or by CD-ROM (e.g. portable medium), a digital index file ('219, column 4, lines 61-67; column 5, lines 60-65). Upon receipt, the user views the digital index file on a computer monitor or TV screen ('219, column/line 5/65-6/3), and selects images to be printed along with the desired size and quantity (i.e. available printing services) by entering next to the respective image the desired choice ('219, figure 5; column 6, lines 1-9). To one of ordinary skill, the screen is an "order screen" as after the user has made her/his selections the user prints the screen and forwards the order to the photo finishing station ('219, column 5, lines 38-45). Further, the screen is updateable as a user can change his/her mind regarding an image to be selected, a size and/or quantity. Recall, the photo finishing station provides the user, via portable medium (e.g. CD-ROM), with image data and print service information ('219, figure 5). Now this "print service information" is updateable as the user is able to edit the information and select the image, size and quantity ('219, figure 5; column 6, lines 1-9). If this were not the case then the user could not enter data onto the screen selecting image, size and quantity ('219, figure 5; column 6, lines 1-9). Hence, contrary to the Appellant's opinion, Moghadam et al. clearly recite "...printing service information being updateable information for use in generating an updateable order screen displaying available printing services from a user selects".

The system of Moghadam et al. is dedicated to “make available for viewing a digitized version of the images that have been developed from the customer’s film and to additionally permit the customer to communicate print ordering instructions to the film processor...” Therefore, to one of ordinary skill the teachings of Moghadam et al. at least suggest the use of an order screen to allow a user to convey “ordering instructions”. Farros et al. teach a method for remote printing comprising an updateable order screen through which a user can define a print product (‘810, abstract; figure 5; column 6, lines 24-67). And, to one of ordinary skill, it would have been obvious to modify the Moghadam et al. reference in order to make the process of ordering print-related goods and services more efficient. Note, Farros et al. provide an “order” button that allows a user to send an order on-line (‘810, figures 5 and 10; column 8, lines 5-8; column 10, lines 60-67; column 53-67), an obvious automation (*In re Venner*, 262 F.2d 91, 95, 120 USPQ 192, 196 (CCPA 1958)) improvement to the Moghadam et al. teaching where the user prints a hard-copy of the order and faxes the order to the photo finishing station (‘219, column 5, lines 38-45).

(12) Conclusion

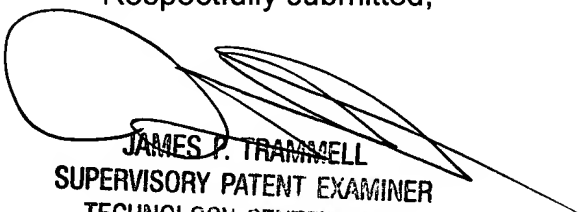
Appellant’s arguments are not persuasive in that they do not give fair credit to the level and knowledge of those of ordinary skill and what would have

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been rendered obvious in light of the combined prior art of Moghadam et al. and Farros et al..

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3300

Calvin Loyd Hewitt II
October 30, 2003

Conferees
James P. Trammell 

John Hayes 

JOHN W. HAYES
PRIMARY EXAMINER

BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747